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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,730	05/17/2000	CHARLES ERIC HUNTER	05001.1020	9231

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EXAMINER
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NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/465,730

Applicant(s)

HUNTER ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7, 10-73 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **Status of the Claims**

1. Claims 1-7, 10-73 are pending in this application according to the amendment filed 2/09/2004.

### **Drawings**

2. This application has been filed with 12 drawing pages, which currently are acceptable for examining purposes.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7 are drawn to a system and a method to place advertisements and orders on multiple electronic billboard displays, (note that independent claim 72 doesn't claim displaying specifically on a bill-board; therefore, a display via the Internet or via house-hold TV would read-on the claimed language.
  - II. Claims 72-73, 10-23, 30-34, 41-43, 47-65, 69-70 are drawn to a general method to place advertisements and orders online.
  - III. Claims 24-26 are drawn to a general method to place advertisements and orders online having a sub-combination of "...wherein the display comprises splitting a display screen into at least two portions and displaying the content on less than the at least two portions...".
  - IV. Claims 27-29 are drawn to a general method to place advertisements and orders online having a sub-combination of "...comprising communicating availability of display locations and time to the merchant...".

- V. Claims 35-40, 44-46 are drawn to a general method to place advertisements and orders online having a sub-combination of "...wherein the identifying step comprises creating a database of customers/merchants...".
- VI. Claims 44-46 are drawn to a general method to place advertisements and orders online having a sub-combination of "wherein the display comprises splitting a display screen into at least two portions and displaying the content on less than the at least two portions".
- VII. Claims 66-68 are drawn to a general method to place advertisements and orders online having a sub-combination of "...comprising verifying product availability ...".
- VIII. Claim 71 is drawn to a general system for facilitating the ordering of a product display, as in a mail order business (e.g. <http://www.valuepak.com>).
4. The inventions are distinct, each from the other because of the following reasons: Inventions II, III, IV, V, VI, VII, and VIII are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions III, IV, V, VI, VII, and VIII have separate utilities as having clearly different applications/functions as indicated above. See MPEP § 806.05(d).
5. Because these inventions are distinct for the reasons given above, because the search required for Group I is not required for Group II or Group VIII the inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as

indicated is proper (MPEP §811 allowing restrictions at anytime prior to the application being under a Final Rejection).

6. Should Applicants disagree with the Examiner and find that, as currently claimed, Inventions I, II and VIII are patent ably distinct, Applicants are respectfully requested, in accordance with 37 C.F.R. § 1.111(b), to make his position known to the Examiner in Applicant's next response.

#### Election of Species

7. This application contains claims directed to the following patent ably distinct species of the claimed invention:

Species A: claims 1-7.

Species B: claims 72-73, 11-70.

Species C: claim 71.

Note that distinct species for indicated claims are explained in part 3.

Applicants are also required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

8. Applicants are advised that a reply to this requirement must include both a choice of invention (i.e., Inventions I-VIII) and an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added in response to this Office Action or in any future amendment. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

9. Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election in response to this Office Action or in any future amendment, Applicants must indicate which newly added claims are readable upon the elected species. MPEP § 809.02(a).

Should Applicants traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention if an election being made.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687/703-746-5572.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

*Cuong H. Nguyen*

*CHAN*

CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3625